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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,555	09/05/2003	Laurence R. O'Halloran	57063.000003	6416

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EXAMINER

PEFFLEY, MICHAEL F

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 09/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/655,555

Applicant(s)

O'HALLORAN, LAURENCE R.

Examiner

Michael Peffley

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 10-20 is/are allowed.
6) ☒ Claim(s) 1-9 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Applicant's amendments and comments, received February 21, 2006, have been fully considered by the examiner. The following is a complete response to the February 21, 2006 communication.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 lacks proper antecedent basis for "the insulated tubing assembly" at line 9. As asserted previously, claim 1 recites "a tubing assembly" in line 3, and therefore fail to provide specific support for "the insulated tubing assembly" recited thereafter.

Claim Rejections - 35 USC § 103

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrison, Jr. (3,828,780) in view of the teaching of Wojciechowicz ('742).

Morrison, Jr. Discloses a cautery suction device including a handle assembly (10), a tubing assembly (32) having a channel therein and a tip assembly (30) at the end of the tubing assembly. The tip assembly includes a cautery tip with an opening in communication with the suction channel. The tubing assembly includes an insulated covering (32) that terminates a predetermined distance from the end of the cautery tip (see Figure 1). Morrison, Jr. also disclose that the tubing assembly may include a bend (Figure 1), and the handle assembly includes an electrical wire (26) that is connected to

Art Unit: 3739

a conductive tube within the handle assembly to provide cautery energy to the cautery tip. A suction control (22) is provided on the handle assembly to control the suction through the central channel. The only feature not expressly taught by Morrison, Jr is a cautery tip that has been sharpened to facilitate tissue dissection.

As addressed previously, Wojciechowicz disclose substantially an identical suction cautery device. In particular, Wojciechowicz teach that the cautery tip may be provided with either a flattened tip (Figures 2-4), or with a beveled, sharpened tip to facilitate tissue dissection (Figures 7A and 7B). To have provided the Morrison, Jr. tip with a sharpened edge to facilitate tissue dissection would have been an obvious modification for one of ordinary skill in the art in view of the teaching of Wojciechowicz.

With regard to claims 4, 5, 12 and 13 the examiner maintains that the particular angle and location of the bend of the Morrison, Jr. device would be an obvious consideration for one of ordinary skill in the art and dependent on the particular procedure.

Similarly, the particular shape of the cautery surface (i.e. semi-cylindrical as set forth in claim 18) is deemed to be an obvious design consideration. The cited prior art shows a variety of shapes for similar cautery surfaces. See, for example, Helenowski (5,084,045).

Response to Arguments

Applicant's arguments with respect to claims 1-9, filed February 21, 2006, have been fully considered but they are not persuasive.

Applicant contends that one of ordinary skill in the art would not have been motivated to provide the Morrison device with a beveled leading edge “without any intervening structure” because the primary teaching of Wojciechowicz is to include thermal insulation member (108) within the coagulating electrode. The examiner disagrees. That Wojciechowicz deem it advantageous to provide an inner insulation member does not preclude one of ordinary skill in the art from using other teachings, such as the sharpened tip, without the insulation member. It is noted that Wojciechowicz disclose the inner insulation member is used with both the flattened embodiment (Figure 6) and the tapered embodiment. Clearly, the insulation member is an improvement realized by Wojciechowicz, but it is not required in a sharpened tip configuration. Wojciechowicz clearly teach that the sharpened tip is provided as an alternative to the flattened distal end to provide for the dissection of tissue. Such a teaching has applicability to any suction coagulator device, and one of ordinary skill in the art would readily recognize that the specific teaching of a sharpened coagulator for dissection may be applied to other suction devices regardless of the use of an internal insulation member.

Allowable Subject Matter

Claims 10-20 are allowed. The prior art fails to disclose the particular suction cautery dissector that includes a cautery surface having a beveled leading edge and an insulating layer terminating at a predetermined distance prior to the leading edge and having a parallel plane as the leading edge. Rather, the prior art shows either the insulation layer and the electrode layer co-terminating in a beveled edge (Reimels

4,548,207) or a beveled edge for the electrode with a flat end for the proximally ending insulation (Cosman 4,411,266 and Edwards et al 5,599,345).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

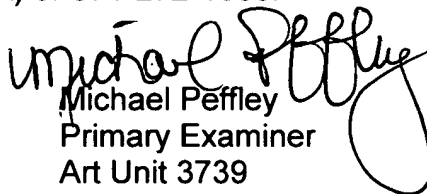
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3739

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Michael Peffley
Primary Examiner
Art Unit 3739

mp
September 11, 2006